

- (a) directing said server to receive a message sent from said client terminal including information capable of identifying said operator;
- (b) directing said server to acquire the information capable of identifying said operator included in said message;
- (c) directing said server to acquire the file name of the file created by said operator based on said information capable of identifying said operator;
- (d) directing said server to generate a file list file by inserting said file name into a skeleton file; and
- (e) directing said server to post the file name of said file list file to said client terminal.

REMARKS

Claims 1-11 are pending in the present application. Claim 10 was amended.

Reconsideration of the claims is respectfully requested.

Amendments were made to the specification to correct errors and to clarify the specification. No new matter has been added by any of the amendments to the specification.

Also, the Applicant has submitted proposed corrections to drawings labeled Figures 2, 6, 7, 8, 9, 10, and 11 in red ink. These changes will be incorporated into a formal set of drawings upon approval of the proposed changes by the Examiner.

I. Objections to Drawings

The Examiner objected to the drawings under 37 CFR § 1.84 for containing reference numerals not mentioned in the description. Figures 2 and 6-11 have been corrected to remove the unmentioned symbols. Also, Figure 11 was objected to for containing two reference numerals associated with the same drawing element; the drawing corrections have obviated this object as well.

The Examiner objected to Figure 2 for labeling "Display Device" as 11, when the specification refers to "display 12." The Applicant has amended the specification to now refer to "CRT 12 or other display 11," which better reflects the content of Figure 2.

Accordingly, the Applicant respectfully requests that the drawing objections be withdrawn.

II. Objections to Specification

The Examiner objected to the specification for containing a spurious “@” symbol on page 8, line 23. The Applicant has removed the “@” and respectfully requests that the objection be withdrawn.

The Applicant acknowledges the presence of the trademarks NETSCAPE NAVIGATOR and INTERNET EXPLORER in the application and have amended the specification to refer to these products in all caps. The Applicant respectfully submits that the generic term “browser” and language acknowledging the status of these terms as trademarks already accompany the marks within the specification. Further, the Applicant respectfully submits that, at least by virtue of the aforementioned amendments, the objection has been overcome by the Applicant. The Applicant therefore respectfully requests that the objection be withdrawn.

The Examiner has objected to the Abstract for beginning with a sentence fragment. The Applicant has amended the Abstract to contain only complete sentences. The Applicant respectfully requests that the object be withdrawn.

III. Objection to Declaration

The Examiner has objected to the declaration, stating that it is defective because it is allegedly unsigned by the Sakaguchi-san, the Applicant. The Applicant respectfully disagrees. The generally accepted definition of a signature is “any symbol executed or adopted by a party with present intention to authenticate a writing.” *See* Uniform Commercial Code § 1-201(39). The Patent and Trademark Office has made no further requirements with regard to the form of signatures.

A copy of the originally submitted declaration is attached to this Response. As reproduced below, Sakaguchi-san’s hand-written signature appears on page two of the declaration on the line labeled “Signature:.” While Sakaguchi-san’s signature is not written in cursive writing, as most signatures in the English-speaking world are, that does not mean that it is not a signature—that is, not a symbol executed or adopted by a party with present intention to authenticate a writing. Moreover, Sakaguchi-san could have even signed the declaration in Japanese characters, as Sakaguchi-san might do in Japan,

and that would still constitute a valid signature. The Applicant respectfully submits that the originally submitted declaration is a properly executed document. The Applicant therefore respectfully request that the objection to the declaration be withdrawn.

2

Docket No. JA9-98-217

As a named inventor, I hereby appoint the following attorneys and/or agents to prosecute this application and transact all business in the Patent and Trademark Office connected therewith:

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IV. Claim Objection

The Examiner objected to claim 10 for containing a spurious "@" symbol. Appropriate correction has been made. The Applicant therefore respectfully requests that the objection be withdrawn.

V. 35 U.S.C. § 102, Anticipation

The Examiner has rejected claims 2-5, 6, 9-11 under 35 U.S.C. § 102(e) as being anticipated by Hunt et al. (hereinafter "Hunt", 5,764,235). This rejection is respectfully traversed.

As per claims 2-4, which are representative of the other rejected claims, the Office Action states:

As per claims 2 and 3, Hunt discloses:

- Generating an image file in response to specifying image data by an operator of said client terminal (column 2, lines 34-40), col. 3, lines 3-4, 6-10, 18-20, 47-52, column 5, lines 1-5, column 9, lines 40-42, column 11, lines 5-9, 31-33, 35-37, 40-42, column 12, lines 20-23, 49-51);
- Converting said image file to generate a predetermined formed compressed image data which has a file name relating to said unique image file name (column 1, lines 48-51, column 8, lines 50-52, column 9, lines 6-15);
- Displaying said predetermined formed compressed image data of said server on a Web browser on said client terminal (column 3, lines 10-12, 49-52, column 5, lines 43-55, column 10, lines 44-49, column 11, lines 11-13, column 12, lines 20-23).

Whenever a server stores, retrieves, or sends a file to a client terminal as a result of a request, the server gives a unique file name to the file in order to distinguish the requested file from other files that are stored on, retrieved, or sent from the server and allowing a record of the transmission to be stored in the server's log or database (column 2, lines 34-43, 47-48, 50-52, column 4, line 66, column 5, lines 1-6, 23-29, column 8, lines 41-44, column 11, lines 5-9). Therefore, determining a unique image file name from the server is inherent in Hunt's disclosure.

Hunt further discloses an image processing that image files undergo at the server to customize the images before being sent to the client. This process modifies the image file using compression (column 5, lines 18-33, column 8, lines 31-52). Therefore, Hunt implicitly discloses sending said predetermined formed compressed image data to said server.

As per claim 4, Hunt discloses a method of communicating on a communication system comprising:

- A client terminal connecting with a network and a server connecting with said network (column 4, lines 63-66, column 5, lines 34-39);
- Storing a file created by an operator of said client terminal which has a name capable of determining that it was created by said operator (column 4, line 66, column 5, lines 1-2, 23-29, column 8, lines 41-44, column 11, lines 5-9);
- Receiving a message sent from the client terminal including information capable of identifying said operator (column 2, lines 34-40, column 3, lines 2-4, 18-19, column 5, lines 26-28, column 11, lines 7-9);

- Acquiring the information capable of identifying said operator included in said message (column 2, lines 37-39, column 3, lines 15-16, column 5, lines 23-29, column 11, lines 7-9);
- Generating a file list by inserting said file name into a skeleton file (column 10, lines 29-54);

Whenever a server stores, retrieves, or sends a file to a client terminal as a result of a request, the server gives a unique file name to the file in order to distinguish the requested file from other files that are stored on, retrieved, or sent from the server and allowing a record of the transmission to be stored in the server's log or database (column 2, lines 34-43, 47-48, 50-52, column 4, line 66, column 5, lines 1-6, 23-29, column 8, lines 41-44, column 11, lines 5-9). Therefore, the use of acquiring a file name of the file created by operator on said information capable of identifying said operator is inherent in Hunt's disclosure.

Hunt further discloses, sending the image file to the client terminal to be displayed with the web page (column 10, lines 37-49). Whenever a file is sent to a client terminal, the file name, which is acquired from the server, is sent with the file. Therefore, posting the file name of said image data to the client terminal is inherent in Hunt's disclosure.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). *Hunt* fails to anticipate the presently claimed invention because it fails to show all of the elements of the claimed invention.

Claims 2, 3, 5, 9, and 10 recite sending image data to a server. This feature is not taught by *Hunt*.

Hunt teaches only a method and system for transmitting graphical images from a server to a client in response to a client request:

As a computer-implemented method for transmitting a graphical image from a server machine to a client machine, an embodiment of the invention performs the operations of: receiving, at the server machine, a request for a graphical image from a client machine, the graphical image being stored on the server machine and having a predetermined total image size; obtaining image control information; determining an appropriate amount of data for the graphical image to be transmitted based on at least the image control information, the appropriate amount being less than or equal to the predetermined total image size; and transmitting the graphical image to the extent of the appropriate amount from the server machine to the client machine. [col. 2, lines 31-43].

The present invention is different. The present invention is directed toward transmitting graphical information from a client to a server, where it can be accessed by other clients:

In one aspect of the present invention, if an image displayed on a display screen of another client terminal is specified, the image is compressed to predetermined formed image data and also given a unique name in the system. This file is automatically sent to a Web server. A Web browser operating on a client terminal is automatically switched to display the file. [p. 4, lines 14-18].

Thus, the fact that the claimed invention sends graphical data to a server is a fundamental difference between the claimed invention and the *Hunt* reference. The Examiner, however, argues that sending the data to the server is inherent to the teachings of *Hunt*. The Applicant respectfully disagrees.

The Examiner has misapplied the concept of "inherent" anticipation. Section 102 of Title 35 deals with novelty and loss of patent rights. An invention is said to be "anticipated" when it is squarely described or disclosed in a single reference as identified from one of the categories of 35 U.S.C. § 102, commonly referred to as "prior art". Express anticipation occurs when the invention is expressly disclosed in the prior art, patent or publication. In some cases, however, when the claimed invention is not described *in haec verba*, the "doctrine of inherency" is relied on to establish anticipation. Under the principles of inherency, a claim is anticipated if a structure in the prior art necessarily functions in accordance with the limitations of a process or method claim. *In re King*, 801 F.2d 1324, 231 U.S.P.Q. 136 (Fed. Cir. 1986).

Mere possibilities or even probabilities, however, are not enough to establish inherency. The missing claimed characteristics must be a "natural result" flowing from what is disclosed. *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 20 U.S.P.Q.2d 1746 (Fed. Cir. 1991). Unstated elements in a reference are inherent when they exist as a "matter of scientific fact". *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 7 U.S.P.Q.2d 1057 (Fed. Cir.), *cert. denied*, 488 U.S. 892 (1988) and *Hughes Aircraft Co. v. United States*, 8 U.S.P.Q.2d 1580 (Ct. Cl. 1988). Otherwise, the invention is not inherently anticipated.

The Examiner argues that because in *Hunt* customization of the graphical data takes place at the server, sending that data to the server is inherent to *Hunt*. The Applicant respectfully disagrees. *Hunt* teaches customizing graphical data that exists on the server, but that does not mean that such data must be sent to the server (e.g., from a client). On the contrary, the server in *Hunt* could easily generate and store its own graphical data. Thus, the claimed feature of sending graphical data to the server is not inherently present in *Hunt*. Therefore, *Hunt* fails to anticipate claims 2, 3, 5, 9, and 10 of the present application.

Furthermore, *Hunt* does not teach, suggest, or give any incentive to make the needed changes to reach the claimed invention as recited in claims 2, 3, 5, 9, and 10. *Hunt* actually teaches away from the presently claimed invention because it teaches only sending data residing on a server to a client as opposed to sending data from a client to a server to make the data available to other clients, as in the presently claimed invention. Absent some teaching or incentive to modify *Hunt* to send data from a client to a server to make the data available to other clients, one of ordinary skill in the art would not be led to modify *Hunt* to reach the present invention when the reference is examined as a whole. Thus, the presently claimed invention can be reached only through an improper use of hindsight using the Applicant's disclosure as a template to make the necessary changes to reach the claimed invention.

Claims 4, 6, and 11, all recite generating a file list file by inserting a file name into a skeleton file. This feature is not taught by *Hunt*.

The Examiner cites col. 10, lines 29-54 as teaching this feature. The Applicant respectfully disagrees. The cited excerpt simply describes downloading an HTML document with image files. No generation of a file list file or any mention of a skeleton file is mentioned:

The web browser processing 900 initially requests 902 a web page. The request for a web page is sent by the web browser 204 through the Internet 206 to the web server 202. The web browser processing 900 then determines 904 whether the web page HTML file has been received in response to the request for the web page. Until the web page HTML file is received (or a time-out occurs to end the processing 900), the web browser processing 900 awaits its reception. Once the web page HTML file has been received, a decision 906 determines whether the web page HTML file includes a graphical image file. If the web page HTML file does

include a graphical image file, a request for the graphical image file is sent 908 to the web server 102. Then, a decision 910 awaits reception of the determined image data from the web server 102 (or a time-out occurs to end the processing 900). Following block 910 when the determined image data has been received or following block 906 when the web page HTML file does not include a graphical image file, the web page is displayed 912. In the case in which blocks 908 and 910 are performed, the web page displayed 912 includes a graphical image file. In the case in which the decision block 906 determines that the web page HTML file does not include a graphical image file, blocks 908 and 910 are skipped and the web browser processing 900 causes the web page to be displayed 912 without any graphical image file. [col. 10, lines 29-54].

As *Hunt* neither teaches nor suggests the claimed feature of generating a file list file, *Hunt* fails to anticipate claims 4, 6, and 11. The Applicant therefore respectfully requests that claims 2-5, 6, 9-11 be allowed.

Furthermore, *Hunt* does not teach, suggest, or give any incentive to make the needed changes to reach the presently claimed invention as recited in claims 4, 6, and 11. *Hunt* is actually non-analogous art, as *Hunt* is directed toward serving requests for Web pages, whereas claims 4, 6, and 11 are directed toward generating file names and file list files from operator identification information. Absent some teaching or incentive to modify *Hunt* to generate file names and file list files from operator identification information, one of ordinary skill in the art would not be led to modify *Hunt* to reach the present invention when the reference is examined as a whole. Thus, the presently claimed invention can be reached only through an improper use of hindsight using the Applicant's disclosure as a template to make the necessary changes to reach the claimed invention.

VI. 35 U.S.C. § 103, Obviousness

The Examiner has rejected claims 1 and 7-8 under 35 U.S.C. § 103(a) as being unpatentable over *Hunt et al.* (hereinafter "*Hunt*", 5,764,235) in view of *Turpin et al.* (hereinafter "*Turpin*", 6,144,992)). This rejection is respectfully traversed.

A. Burden

The Office bears the burden of establishing a *prima facie* case of obviousness based on the prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). The Examiner has failed to meet that burden for the following reasons.

B. References must teach all elements of the rejected claims

For an invention to be *prima facie* obvious, the prior art must teach or suggest all claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

With regard to claims 1 and 7-8, the references fail to teach or suggest all elements of these claims. These independent claims all recite the aforementioned feature of “sending image data to the server.” As previously stated, *Hunt* does not teach or suggest this feature. *Turpin*, which is not directed toward image file manipulation, does not teach or suggest this feature, either. Therefore, for at least the reasons already discussed with respect to claims 2, 3, 5, 9, and 10, claims 1 and 7-8 are also patentable over the references.

In addition, the claimed feature of posting the file name of the image data to a client terminal, which is incorporated in claims 1 and 7-8, is also not taught or suggested by the references. The Examiner argues that because *Turpin* teaches transmitting files to a client terminal, the claimed feature of posting the file name to a client terminal is inherently present in *Turpin*. Specifically the Examiner states:

Whenever a file is sent to a client terminal, the file name, which is acquired from the server, is sent with the file. Therefore, posting the file name of said image data to the client terminals collaborating with said client terminal is taught in *Turnip*’s disclosure. [p. 12].

The Applicant disagrees with the Examiner’s statement that whenever a file is sent to a client terminal, the file name is sent with the file. The Examiner has not provided any evidence from the prior art to verify this statement. If the Examiner is basing such statement on personal knowledge, the Applicant challenges this unsupported assertion and respectfully requests that the Examiner comply with 37 CFR § 1.104(d)(2)

and provide support for the Examiner's argument in the form of an affidavit "subject to contradiction or explanation by the affidavits of the applicant or other persons."

Otherwise, the Examiner has failed to meet the prima facie burden of proving obviousness, and claims 1 and 7-8 should be allowed.

C. No motivation to combine or modify the references to achieve the present invention exists in the prior art

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Even if the missing elements of the rejected claims existed in the prior art, for the rejected claims to be obvious there must be some motivation or incentive from the prior art to modify or combine the reference teachings to achieve the present invention. The Examiner suggests that "for graphical images to be transmitted and displayed more flexibly and efficiently by reducing transmission time, conserving network bandwidth, and reducing the loads placed on server machines" is a possible motivation to combine the references. The Examiner's argument is meaningless, however, because the two prior art references are directed toward entirely different problems from both each other and the problem the Applicant's invention solves. *Hunt* is directed toward serving customized image files at a Web server. *Turpin* is directed toward installing software and system files across a plurality of computers in a network. The present invention is directed toward computer-facilitated collaboration among members of a group, which is a different problem from that of either of the prior art references.

Moreover, the Examiner has not provided any motivation *from the prior art* that making all the necessary modifications to the reference teachings to achieve the present invention would be desirable. If the Examiner cannot make such a showing, then the Examiner has simply relied on hindsight with the benefit of the Applicant's disclosure to

develop an incentive for the changes, which in fact, would not be obvious to one of ordinary skill in the art at the time the invention was made.

Therefore, the Applicant respectfully submits that claims 1 and 7-8 are patentable over *Hunt* and *Turpin*. The Applicant therefore respectfully requests that claims 1 and 7-8 be allowed.

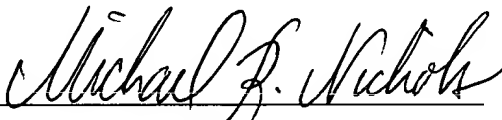
VII. Conclusion

It is respectfully urged that the subject application is patentable over the references and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: 31 October 2002

Respectfully submitted,

A handwritten signature in cursive script, reading "Michael R. Nichols", written over a horizontal line.

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Appendix A: Redacted Paragraphs

The paragraph that began at page 2, line 8 reads as follows:

A Web client or a client (in general, a computer which executes a program called a browser) is essentially a hypertext reader which communicates with a Web server via a specific data transfer protocol such as the hypertext transfer protocol (HTTP). A client requests a hypertext file by using the appropriate URL and displays the file (called a Web page) on a graphical user interface (GUI). A Client can also return specific data to a server and call a common gateway interface (CGI) program to perform a specific task. Currently, [Netscape Navigator] NETSCAPE NAVIGATOR (trademark of Netscape Communications Corporation) and [Internet Explorer] INTERNET EXPLORER (trademark of Microsoft Corp.) are known as general browsers.

The paragraph that began at page 8, line 14 reads as follows:

In a still further aspect of the present invention, a storage medium storing a software product for controlling communication performed on a communication system having a client terminal connecting a server through a network is provided, the software product comprising the program codes for: (a) directing the client terminal to generate an image file in response to specifying image data by an operator of the client terminal; (b) directing the client terminal to determine a unique image file name on the server; (c) directing the client terminal to convert the image file and generate a predetermined formed compressed image data which has a file name relating to the image file name acquired from the server; (d) directing the client terminal to send the predetermined formed compressed image data to the server; [and] and (e) directing the client terminal to display the predetermined formed compressed image data of the server on a Web browser on the client terminal.

The paragraph that began at page 11, line 3 reads as follows:

Fig. 1 is a conceptual diagram of a data processing system in a preferred embodiment of the present invention. On information terminals 110 and 120 on the client side, Web browsers such as [Netscape Navigator] NETSCAPE NAVIGATOR (a trademark of Netscape Communications Corporation) and [Internet Explorer]

INTERNET EXPLORER (a trademark of Microsoft Corp.), etc. are installed. The operator of client terminal 110 selects an image and a file displayed on a desktop after moving processing elements of the present invention, and then the data processing system of the present invention determines a unique image file name in the system and generates predetermined formed compressed image data.

The paragraph that began at page 12, line 5 reads as follows:

Client terminals 110, 120 and Web server 140 can also have user interface hardware including pointing device 7 (a mouse, a joystick etc.) or keyboard 6 and [display] CRT 12 or other display 11. A touch panel can also be a means for entry. It is also possible to connect with a printer via parallel port 16 or a modem via serial port 15. This information terminal support server 100 can be connected with a network via serial port 15 and a modem or communication adapter 18 (Ethernet or Token-ring card) etc. so as to communicate with other computers and so on.

The paragraph that began at page 35, line 17 reads as follows:

[To allow] The present invention is directed toward a method, software product, and apparatus for allowing various kinds of information existing on a client terminal to be referred to on a Web browser of another collaborating client terminal. If an image displayed on a display screen of client terminal is specified, the image is compressed to a predetermined formed image data and also given a unique name in the system. This file is automatically sent to a Web server. A Web browser operating on the client terminal is automatically switched to display the file. A Web browser of another client terminal collaborating with this client terminal is also switched to display the file.

Appendix B: Redacted Claims

10. (amended) A storage medium storing a software product for controlling communication performed on a communication system having a client terminal connecting a server through a network, said software product comprising the program codes for:

- (a) directing said client terminal to generate an image file in response to specifying image data by an operator of said client terminal;
- (b) directing said client terminal to convert said image file and generate a predetermined formed compressed image data;
- (c) directing said client terminal to send said predetermined formed compressed image data to said server;
- (d) directing said client terminal to determine a unique image file name on said server and post it to said client terminal; [@and] and
- (e) directing said client terminal to display said predetermined formed compressed image data of said server on a Web browser on said client terminal.



#

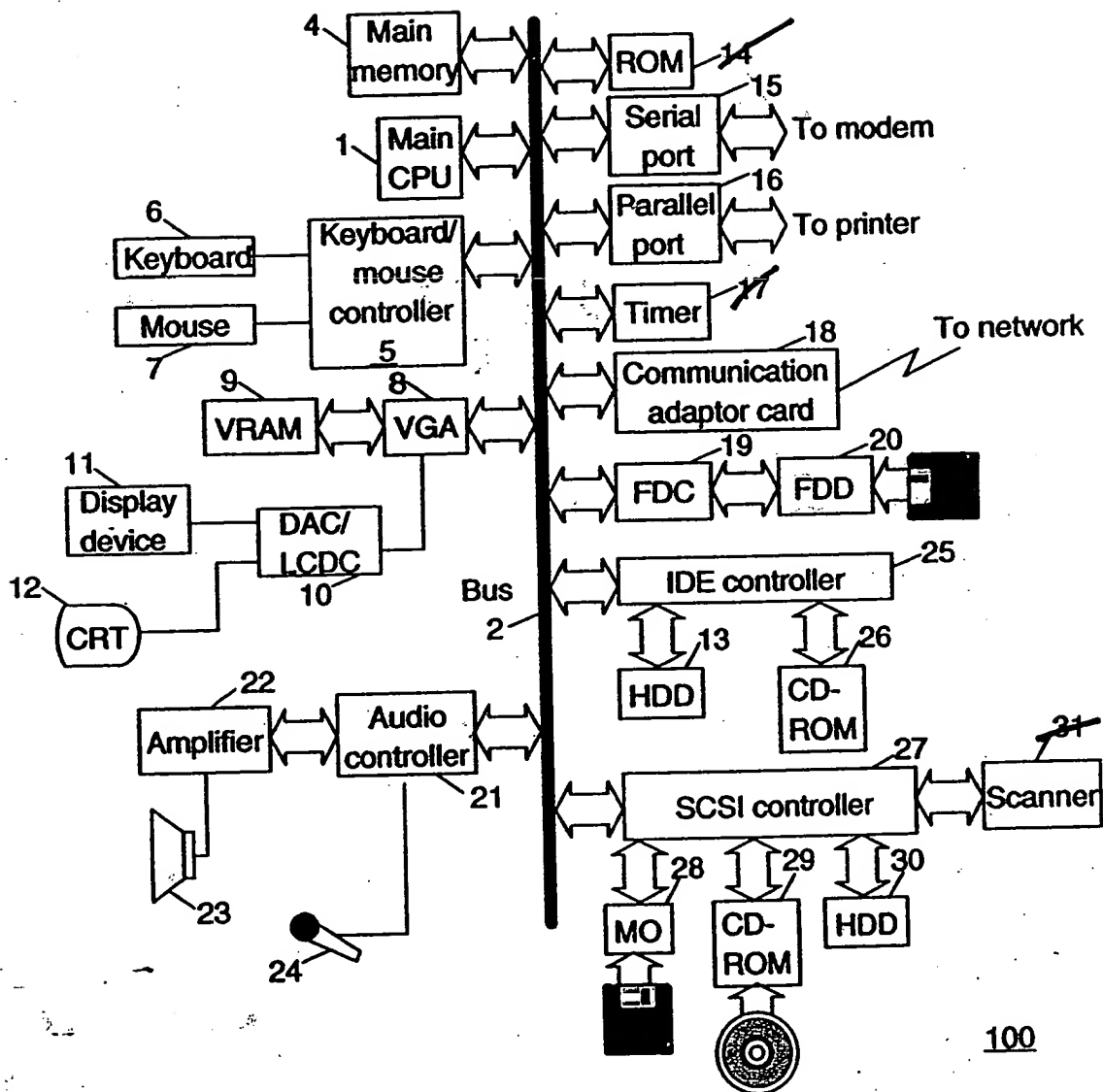


FIG. 2

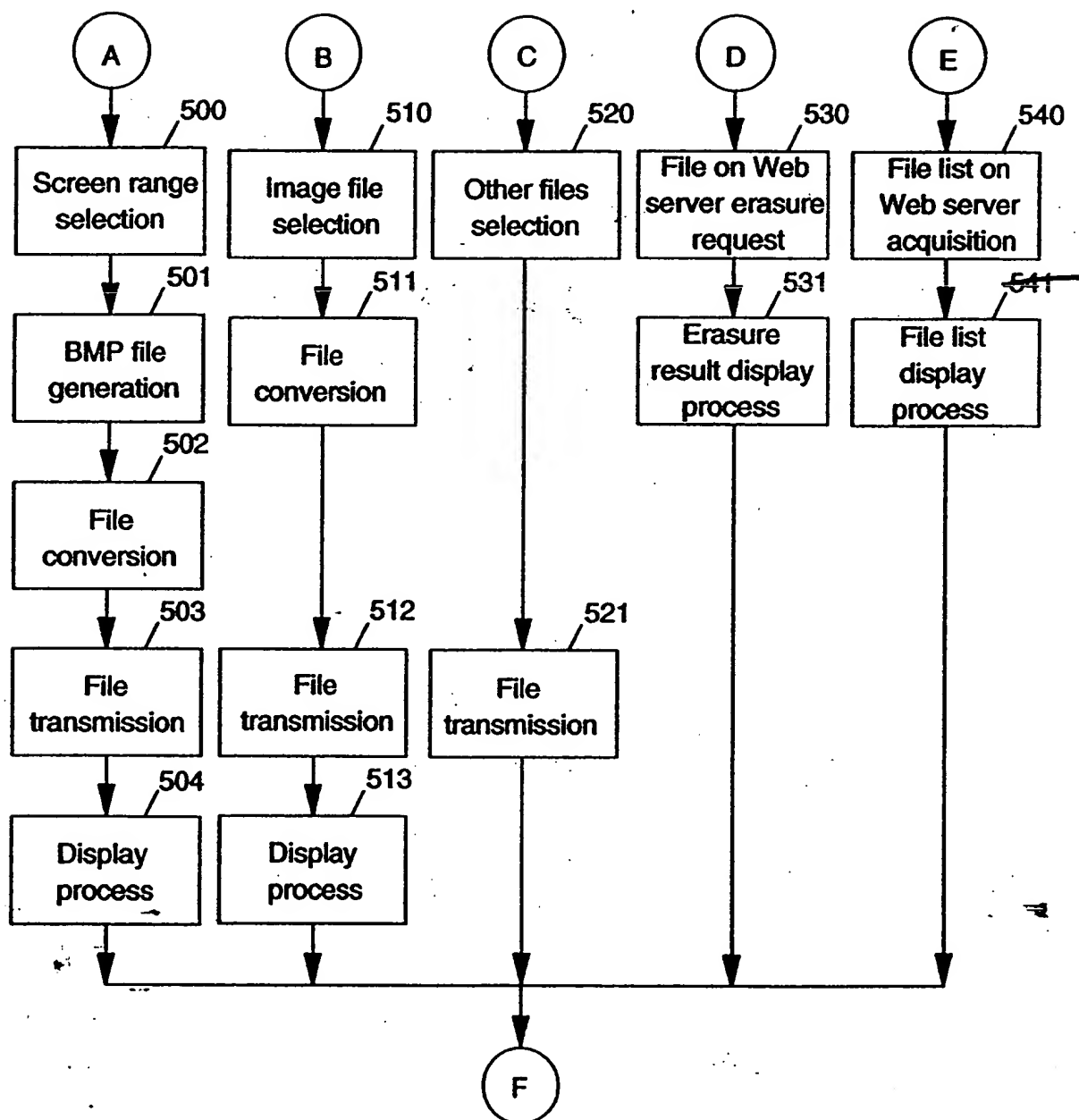


FIG. 6

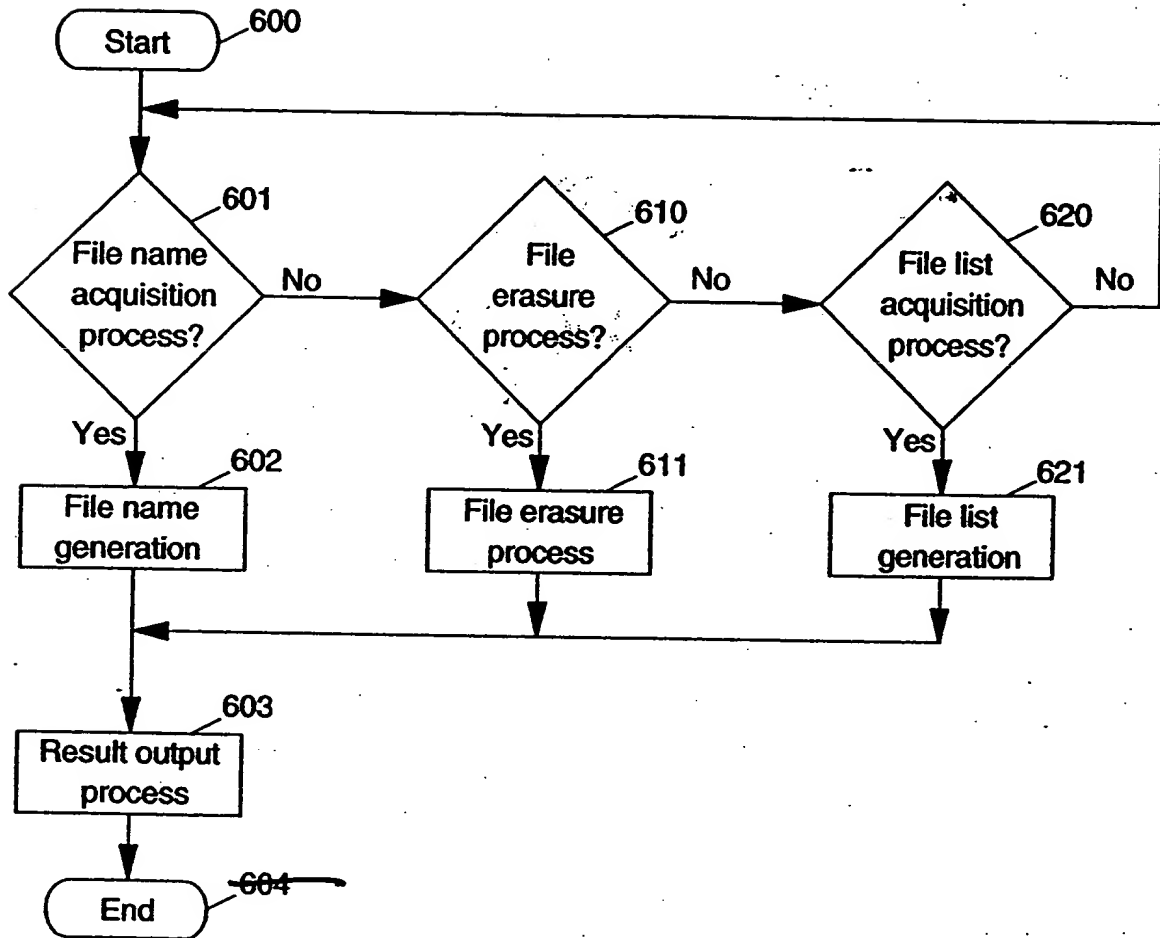


FIG. 7

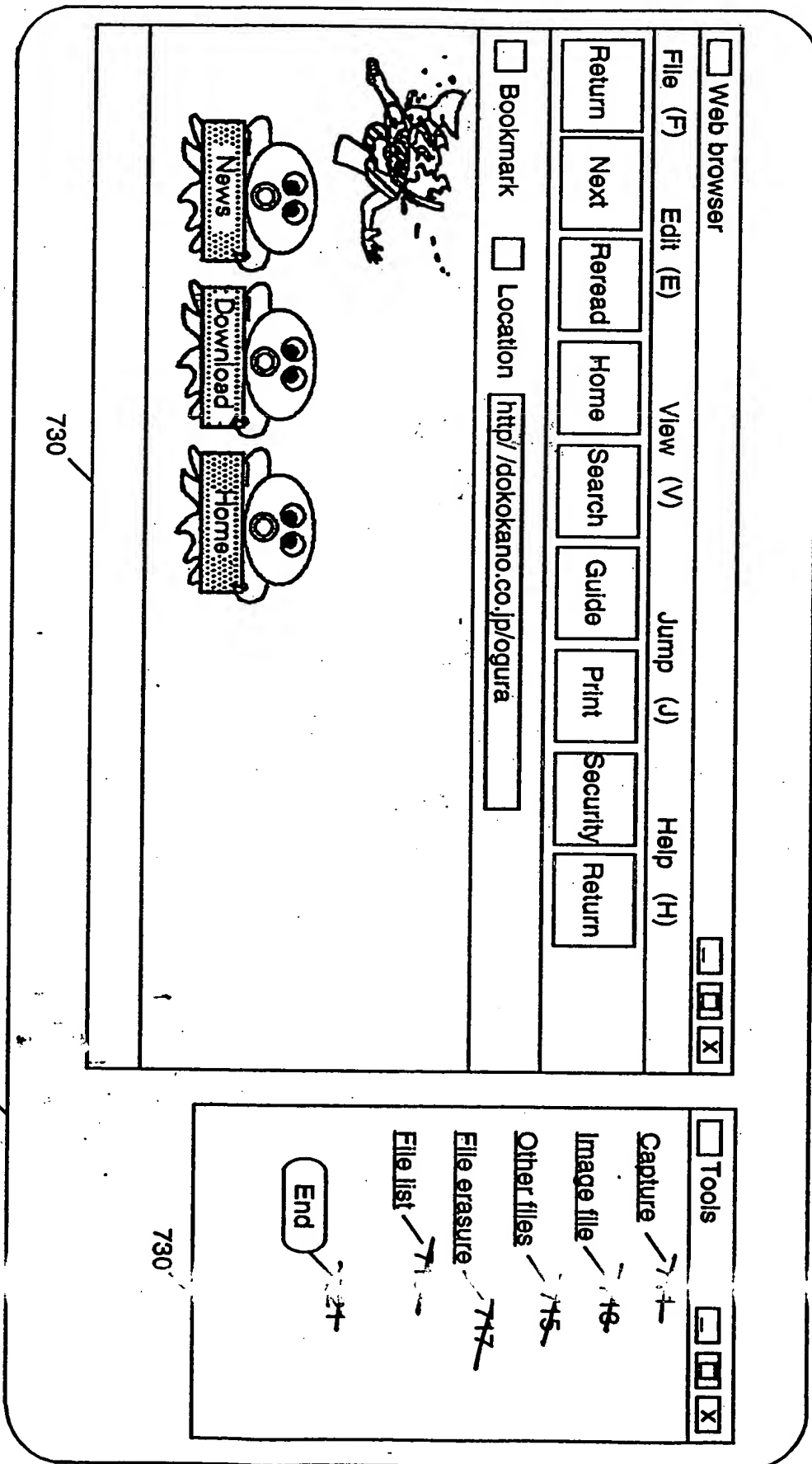


FIG. 8



☐ Web browser

File (F)

Edit (E)

View (V)

Jump (J)

Help (H)

Return

Next

Reread

Home

Search

Guide

Print

Security

Return

☐ Bookmark ☐ Location <http://dokokano.co.jp/ogura/download>

~~784~~

* Download page

You can download photos of the sea.

730

☐ Tools

Capture

Image file

Other files

File erasure

File list

End

730

FIG. 9



☐ Web browser

File (F)

Edit (E)

View (V)

Jump (J)

Help (H)

Return

Next

Reread

Home

Search

Guide

Print

Security

Return

☐ Tools

Capture

Image file

Other files

☐ Web browser

File (F)

Edit (E)

View (V)

Jump (J)

Help (H)

Return

Next

Reread

Home

Search

Guide

Print

Security

Return

☐ End

☐ Bookmark

☐ Location

<http://dokokano.co.jp/ogura/download>

☐ Download

☐ You can save it by pressing the right mouse button on a link of a file name.

* The Sea of Japan ~~744~~

* The Inland Sea ~~745~~

* Tochinoumi ~~746~~

FIG. 10

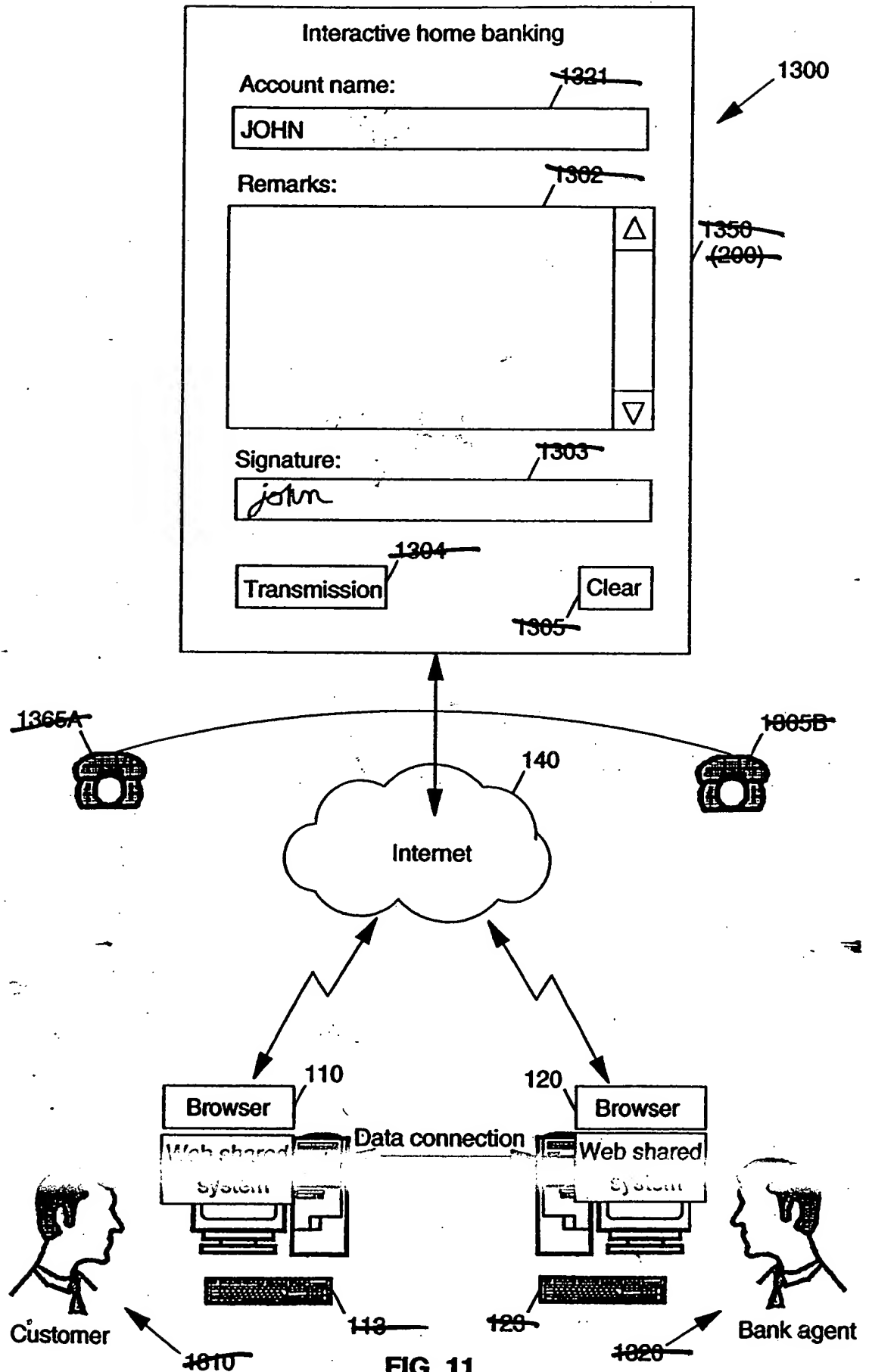


FIG. 11